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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,670	12/31/2003	Lionel Poincenot	CLEV:628	2778
6160	7590	12/05/2005	EXAMINER	
PARKHURST & WENDEL, L.L.P. 1421 PRINCE STREET SUITE 210 ALEXANDRIA, VA 22314-2805			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,670

Applicant(s)

POINCENOT ET AL.

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 4, 8, 13 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-12, 14-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. The restriction stands due to the different searches required even within the same classification area. As such the restriction requirement is final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-7, 9-10, 12, 14-15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimazaki.

Shimazaki discloses an iron type head having a center of gravity (CG), a static contact point (SCP) on a sole, a SCP able to be vertically below a CG at an address position with no point lower than a SCP in the form of a golfer placing a head on a ground in this orientation (Figs. 6-7), an SCP and at least two other points substantially vertically below the CG defining a non-planar static contact surface area (SCA) in the form of the sole have a curved shape to it (Fig. 6), a SCP and at least one other point

Art Unit: 3711

substantially vertically below the CG define a contact line (SCL) in the form of when the club is addressed as shown in figure 6 since as shown by figures 6-7 the lowest bottom of the sole shows a straight line profile from the front to rear direction (Fig. 7), a centerline plane orthogonal to the plane of the club face and containing the centerline of the face, a center of gravity lying in the centerline plane (Fig. 6, [0013], [0014]), the lowest point (LP) on a sole also lying substantially in a centerline plane when a center line plane is substantially vertical (Fig. 6), a non-planar lowest point surface area (LPA) comprised of points substantially vertically below a center of gravity when a centerline plane is vertical and not points of a sole are lower than the LP when a centerline plane is vertical (Fig. 6), and a head having both a SCA and a LPA (Fig. 6) by addressing a head differently for a SCA.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimazaki.

Shimazaki lacks a head having both a SCP and a LP with a SCP and at least one other point substantially vertically below the CG defining a static contact line SCL.

Art Unit: 3711

Shimazaki discloses a profile for the face to the back having a straight configuration and contour lines near a toe end of a sole of a head having straight lines from the face to the back of a head (Fig. 7). Clearly an artisan skilled in the art of forming an iron head with a rounded sole from the heel to the toe would have selected a suitable profile from the face to the back of an iron at a sole other than where the sole contacts the ground in figure 6 in which a straight profile from the face to the back is included. It would have been obvious to modify the head of Shimazaki to have a head having both a SCP and a LP with a SCP and at least one other point substantially vertically below the CG defining a static contact line SCL in the form of the straight line from the face to the back in order to utilize a known method in the market place of forming soles from the heel to toe used in making golf club heads.

Response to Arguments

6. The argument that declaration Under 37 C.F.R. 1.131 dated 2 September 2005 antedates the reference of Shimazaki is disagreed with. The declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claims as a whole reads on it (See MPEP 715.02). The declaration merely shows a picture of an iron head which has a sole and center of gravity (inherent). There are no facts which show the rest of the structure of any of the independent claims which has to be the inventive part

of the claims since iron type heads with soles and center of gravities are very old in the art. The declaration lacked the following:

- a. For claim 1, a static contact point SCP on said sole, said SCP being substantially vertically below the CG when said club head is in an address position, and said sole has no points lower than said SCP when said club head is in the address position.
- b. For claim 6, having a centerline plane orthogonal to the plane of the club face and containing the centerline of the club face, with the center of gravity lying in said centerline plane and the lowest point LP on said sole also lying substantially in said centerline plane when the centerline is substantially vertical.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/ 21 November 2005


STEPHEN BLAU
PRIMARY EXAMINER